



PATENT
12346/46004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee : O'Brien et al.

Patent No. : 5,714,459

Grant Date : February 3, 1998

08/484594

Title : USE OF PROSAPOSIN AND NEUROTROPHIC PEPTIDE
DERIVED THEREFROM

Assignee : Myelos Corporation

Mail Stop Petition
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

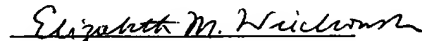
Sir:

Please find a Petition to Accept an Unavoidably Delayed Payment of a Maintenance Fee in Expired Patent Under C.F.R. §1.378(a) and to Reinstate U.S. Patent No. 5,714,459 (the Petition) transmitted herewith for filing in the above-identified patent.

Payment of any required fees have been identified and authorized in the Petition, a duplicate copy of the Petition is enclosed for charging purposes. No additional fees are believed to be due at this time, however if any additional fee is required, please use Deposit Account No. 11-0600. A duplicate of this transmittal letter is enclosed for that purpose.

Respectfully submitted,

Date: April 26, 2005


Elizabeth M. Wieckowski
Registration No. 42,226
Kenyon & Kenyon
One Broadway
New York, New York 10004
212 425-7200
212 908-6140 (Direct)
212 425-5288 (Fax)
CUSTOMER NO. 26646

05/05/2005 DALLEN 00000004 110600 5714459

01 FC:2551 450.00 DA
02 FC:1557 700.00 DA

Express Mail No EV 321 843 637 US



PATENT
12346/46004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee : O'Brien et al.
Patent No. : 5,714,459
Grant Date : February 3, 1998
Title : USE OF PROSAPOSIN AND NEUROTROPHIC PEPTIDE
DERIVED THEREFROM
Assignee : Myelos Corporation

Mail Stop Petition
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO ACCEPT AN UNAVOIDABLY DELAYED PAYMENT OF A
MAINTENANCE FEE IN EXPIRED PATENT UNDER 37 C.F.R. §1.378(a) AND TO
REINSTATE U.S. PATENT NO. 5,714,459**

Sir:

This Petition is submitted to request that the Commissioner accept payment of the maintenance due in the above-identified patent which was due with a surcharge on February 3, 2002. The delay in payment of the fee was unavoidable as reasonable care was taken to ensure that the maintenance fee was paid timely and this petition is being filed promptly upon notification of the patentee of the expiration of the patent.

A. The Requirements of a Petition to Accept an Unavoidably Delayed Payment of a Maintenance Fee

A petition to accept an unavoidably delayed payment of a maintenance fee under 37 C.F.R. §1.378(a) must be accompanied by:

- (1) the required maintenance fee set forth in §1.20 (e) through (g);
- (2) the surcharge set forth in §1.20(i)(1); and

- (3) a showing is made that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition to accept the unavoidably delayed maintenance fee was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which the patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Under §1.378 (d), any petition under this section must be filed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

B. Requirements for a Petition to Accept an Unavoidably Delayed Payment of a Maintenance Fee Are Met for this Patent

(1) The Required Maintenance Fee Set Forth in §1.20 (e) through (g)

The Commissioner is authorized to charge Kenyon & Kenyon's Deposit Account No. 11-0600 the \$450.00 petition fee set forth in §1.20(e) for the maintenance fee due at 3.5 years for a small entity.

(2) The Surcharge Set Forth in §1.20(i)(1)

The Commissioner is authorized to charge Kenyon & Kenyon's Deposit Account No. 11-0600 the \$700.00 surcharge fee after expiration in which late payment is unavoidable.

(3) The Showing That the Delay Was Unavoidable

(a) Reasonable Care Was Taken to Ensure That the Maintenance Fee Would Be Paid Timely

Myelos Corporation ("Myelos") is a wholly owned subsidiary of Savient Pharmaceuticals, Inc., formerly known as Bio-Technology General Corp. ("BTG"). Myelos is the assignee of the entire right and interest in U.S. Patent No. 5,714,459. BTG acquired

Myelos Corporation on March 19, 2001 through BTG-owned Myls Acquisition Corp. Myelos Corporation merged with and into Myls Acquisition Corp.

Knobbe Martens, Olson & Bear, LLP (“Knobbe”) of Newport Beach, California was the outside patent counsel for Myelos. As part of the above transactions within BTG, responsibility for the patent portfolio of Myelos was transferred to Kenyon & Kenyon and BTG (as Savient was known). On or about October 25, 2001, the physical files that constituted the entire¹ Myelos patent portfolio were transferred to Kenyon & Kenyon in New York, New York from Knobbe. The Myelos patent portfolio included 81 issued Myelos patents and patent applications.

Upon receipt, each of the Myelos files were reviewed by Kenyon & Kenyon for outstanding deadlines and docketed. The transferred file for issued U.S. Patent No. 5,714,459 contained a status summary sheet dated October 22, 2001, which was designated by Knobbe as case number MYELOS.002DV2. *See Tab 1.* The status sheet indicated that the 3.5 year maintenance fee had been paid. Specifically, for a deadline of 03-Aug-2001, the status sheet indicated that action was taken on 02-Aug-2001. (Emphasis added)

The transferred file also contained a Maintenance Renewal Reminder mailed to Knobbe on August 28, 2001, which was docketed on September 24, 2001 for a 3 ½ year maintenance fee with surcharge due February 3, 2002. The back of the reminder had two date stamps “Received, Newport Beach, Docketing, Sep 20 2001, Knobbe, Martens, Olson & Bear, LLP” and “Received, San Diego, Docketing, Oct 01 2001, Knobbe, Martens, Olson & Bear, LLP.” *See Tab 2.*

The file did not contain any correspondence from Knobbe to indicate that the 3.5 year maintenance fee had not been paid and was still outstanding at the time the file was transferred to Kenyon & Kenyon.

In addition, just before the transfer of the Myelos patent portfolio to BTG’s outside patent counsel Kenyon & Kenyon, Robert M. Shaw (former patent counsel of BTG) sent a letter to Kenyon & Kenyon, which enclosed letters from the Knobbe law firm to BTG pertaining to various Myelos patent applications to which BTG has not yet responded. *See Tab 3.* One of the attached letters is the first page of a letter dated September 7, 2001 from

¹ One file was transferred at a later date.

Eric S. Furman, Ph.D. of Knobbe to Robert Shaw requesting instructions for the payment of the maintenance fee for U.S. Patent No. 5,714,459 on which is handwritten "**Paid**". *See Tab 4*. This letter also apprised Kenyon & Kenyon that the maintenance fee had been paid by October 11, 2001, *i.e.*, before the file was transferred from Knobbe.

Based on the understanding that the maintenance fee had been paid, Kenyon & Kenyon docketed a deadline for the 7.5 year maintenance fee (also referred to as the 8th year annuity), which is due on August 3, 2005. A copy of the pertinent records maintained by Kenyon & Kenyon are attached hereto. *See Tab 5*. A copy of the Patent Jacket Data Sheet, which is attached to the file, indicates that the 8 year annuity is due 03-Aug-2005. *See Tab 6*.

Thus, it is respectfully submitted that reasonable care was taken to ensure timely payment of the maintenance fee for this patent.

(b) Promptly Filing of Petition after the Patentee Was Notified of, or Otherwise Became Aware of, the Expiration of the Patent

From the time of transfer of the Myelos patent portfolio to about December 2003, Robert M. Shaw, Esq., the former Senior Vice President, General Counsel and Secretary of BTG, in Iselin, New Jersey, provided instructions to Kenyon & Kenyon on matters relating to Myelos. Since about December 2003, Bio-Technology General (Israel) Ltd. ("BTGIL"), the Israeli subsidiary of Bio-Technology General Corp. ("BTG"), has been responsible for providing instructions to Kenyon & Kenyon for patent prosecution matters relating to Myelos.

Savient is presently undergoing an internal reorganization. The reorganization is expected to be completed by June/July 2005. As part of this reorganization, responsibility for the Myelos patent prosecution files, currently handled by BTGIL, will be transferred to Savient. In preparation for this internal transfer, BTGIL is in the process of summarizing upcoming deadlines for the Myelos patents and preparing files for shipment to Savient. In connection with this preparation, on March 31, 2005, Bio-Technology General (Israel) Ltd (BTGIL) in Rehovot, Israel learned from the U.S. PTO website that the above-referenced patent was apparently abandoned for failure to pay the 3.5 year maintenance fee (also referred to as the 4th year maintenance fee) which was due by August 2, 2001. Gail Volman Ph.D., of the Intellectual Property Department of BTGIL informed the undersigned, an associate of Kenyon & Kenyon, of the lapsed patent on the same day.

The undersigned advised the docket department of Kenyon & Kenyon and other attorneys and paralegals either previously or currently involved in Myelos matters of Dr. Volman's notification of the expiration of the patent on the same day. An investigation was immediately undertaken to determine the facts surrounding the 3.5 year renewal fee.

Kenyon & Kenyon contacted the Knobbe law firm to determine whether it had received any correspondence from the U.S. PTO relating to expiration of the '459 patent. On April 22, 2005, Dr. Eric Furman of Knobbe advised the undersigned that there is no record of receipt by Knobbe of a notice of expiration from the U.S. PTO. Further, under standard Knobbe procedures, Knobbe would have forwarded any correspondence relating to a transferred file to the new patent counsel, *i.e.*, Kenyon & Kenyon. Since Knobbe did not receive any correspondence from the U.S. PTO indicating that the '459 patent had expired, Knobbe did not send any correspondence to Kenyon & Kenyon relating to the '459 patent after the physical file for this patent had been transferred. In the absence of any notification that the '459 patent had expired until the assignee learned of its expiration and notified Kenyon & Kenyon, the payment of the maintenance fee was unavoidably delayed.

It is respectfully submitted that this petition is being promptly filed after the patentee, became aware of the expiration of the patent. In the present case, the assignee became aware of the expired patent and immediately notified Myelos' outside patent counsel.

(4) Signature Required Under §1.378 (d)

This petition is being signed by an attorney registered to practice before the Patent and Trademark Office, as required under §1.378 (d).

In view of the foregoing, attorneys for the assignee earnestly solicit acceptance of the unavoidably delayed maintenance fee and an expeditious reinstatement of U.S. Patent No. 5,714,459.

If a telephone interview would be of assistance in resolving any issue in connection with this Petition, assignee's undersigned attorney invites the Office to telephone at the number provided below.

Respectfully submitted,

Date: April 16, 2005

Elizabeth M. Wieckowski
Elizabeth M. Wieckowski
Registration No. 42,226
Kenyon & Kenyon
One Broadway
New York, New York 10004
212 425-7200
212 908-6140 (Direct)
212 425-5288 (Fax)

CUSTOMER NO. 26646

NY01 978344

Country Application

Monday, October 22, 2001

Case Number: MYELOS.002DV2

Country: US United States of America

SubCase:

NP Instr. Date:

Case Type: DIV

Status: ISSUED

Application Number: 08/484594

Filing Date: 07-Jun-1995

Patent Number: 5714459

Issue Date: 03-Feb-1998

Publication Number:

PublicationDate:

Expir. Date: 30-Jul-2013

Entity: SE

AbandonedDate:

Agent:

Client: MYELOS

Prosecuting

Agent Ref#:

Tax Due Date:

Priority Date:

Annuity Number:

BarCodeDate:

Priority Number:

Tax Start Date:

Assignee: MYELOS CORPORATION

Inventors: O'BRIEN, JOHN S.

Invention Attorney(s): NAI

KISHIMOTO, YASUO

Title: USE OF PROSAPOSIN AND NEUROTROPHIC PEPTIDES DERIVED THEREFROM

Remarks:

User ID:

Date Created: 16-Jun-2000

Last Update: 13-Feb-1998

List Of User Actions

Action(s) Due	Due Date	Indicator	Action Taken
11 1/2 GRACE PR	03-Feb-2010	Final	
Tax 11.5	03-Aug-2009	Due Date	
11 1/2 YR L/C	03-Feb-2009	Reminder	
7.5 GRACE PER.	03-Feb-2006	Final	
Tax 7.5	03-Aug-2005	Due Date	
7 1/2 YR. L/C	03-Feb-2005	Reminder	
3.5 GRACE PER.	03-Feb-2002	Final	
Tax 3.5	03-Aug-2001	Due Date	02-Aug-2001
US-ASSIGNMENT Follow Up Date	15-Mar-2001	Due Date	15-Sep-2000
3 1/2 YR. L/C	03-Feb-2001	Reminder	
ASSIGN REC'D?	13-Nov-2000	Due Date	15-Sep-2000
POSTCARD REC'D?	13-Oct-2000	Reminder	15-Sep-2000
REISSUE APP DUE	03-Feb-2000	Final	03-Feb-2000
*L/C REISSUE AP	03-Aug-1999	Reminder	03-Aug-1999
PAT PROOFREAD	30-Jun-1999	Due Date	
Action Status Chk:	01-Oct-1998	Due Date	01-Oct-1998
Action Status Chk:	03-Aug-1998	Due Date	03-Aug-1998
Action Status Chk:	16-Jul-1998	Due Date	16-Jul-1998
Action Status Chk:	15-Jul-1998	Due Date	15-Jul-1998
Action Status Chk:	24-Apr-1998	Due Date	24-Apr-1998
Action Status Chk:	21-Apr-1998	Due Date	21-Apr-1998
ASSIGNMENT REC	16-Apr-1998	Reminder	31-Mar-1998
Action Status Chk:	09-Apr-1998	Due Date	09-Apr-1998
I/F RECEIPT	09-Apr-1998	Reminder	15-Jan-1998
POSTCARD REC'D	17-Mar-1998	Reminder	31-Mar-1998

Country Application

Monday, October 22, 2001

Action Status Chk:	08-Mar-1998	Due Date	08-Mar-1998
F/D 3 MONTH EXT	03-Mar-1998	Final	09-Oct-1997
F/D 2 MONTH EXT	03-Feb-1998	Reminder	09-Oct-1997
RESUBMIT ASSIGN	14-Jan-1998	Final	16-Jan-1998
F/D 1 MONTH EXT	03-Jan-1998	Reminder	09-Oct-1997
POSTCARD REC'D	09-Dec-1997	Reminder	15-Jan-1998
POSTCARD REC'D	08-Dec-1997	Reminder	21-Oct-1997
Action Status Chk:	04-Dec-1997	Due Date	04-Dec-1997
Action Status Chk:	04-Dec-1997	Due Date	04-Dec-1997
FORMAL DWGS DUE	03-Dec-1997	Due Date	09-Oct-1997
ISSUE FEE DUE	03-Dec-1997	Final	09-Oct-1997
ASSIGNMENT REC	28-Nov-1997	Reminder	24-Oct-1997
POSTCARD REC'D	27-Oct-1997	Reminder	24-Oct-1997
POSTCARD REC'D	13-Oct-1997	Reminder	03-Feb-1998
STATORY PERIOD	04-Sep-1997	Final	04-Jun-1997
STATUTORY PERIO	04-Sep-1997	Final	08-Sep-1997
APPEAL 2ND EXT	04-Aug-1997	Reminder	08-Sep-1997
APPEAL 2ND EXT	04-Aug-1997	Reminder	04-Jun-1997
POSTCARD REC'D	03-Aug-1997	Reminder	04-Jun-1997
APPEAL 1ST EXT	04-Jul-1997	Reminder	08-Sep-1997
APPEAL 1ST EXT	04-Jul-1997	Reminder	04-Jun-1997
Action Status Chk:	09-Jun-1997	Due Date	09-Jun-1997
NOTICE APPEAL	04-Jun-1997	Due Date	08-Sep-1997
NOTICE APPEAL	04-Jun-1997	Due Date	04-Jun-1997
Action Status Chk:	19-May-1997	Due Date	19-May-1997
FINAL AMEND DUE	04-May-1997	Due Date	04-Jun-1997
AMEND. 3RD EXT.	22-Jan-1997	Final	19-Nov-1996
AMEND. 2ND EXT	22-Dec-1996	Reminder	19-Nov-1996
POSTCARD REC'D	10-Dec-1996	Reminder	09-Dec-1996
AMEND. 1ST EXT	22-Nov-1996	Reminder	19-Nov-1996
AMENDMENT DUE	22-Oct-1996	Due Date	19-Nov-1996
Action Status Chk:	04-Sep-1996	Due Date	04-Sep-1996
STATUS CK	07-Jun-1996	Due Date	07-Jun-1996
POSTCARD REC'D	13-May-1996	Reminder	04-Mar-1996
Action Status Chk:	13-Mar-1996	Due Date	13-Mar-1996
Action Status Chk:	22-Feb-1996	Due Date	22-Feb-1996
Action Status Chk:	17-Feb-1996	Due Date	17-Feb-1996
Action Status Chk:	07-Feb-1996	Due Date	07-Feb-1996
FINAL MSNG PRS	25-Dec-1995	Final	17-Aug-1995
MISS PART 3 EXT	25-Nov-1995	Reminder	17-Aug-1995
ASSIGNMENT REC	17-Nov-1995	Reminder	
POSTCARD REC'D	17-Nov-1995	Reminder	13-Sep-1995
POSTCARD REC'D	26-Oct-1995	Reminder	22-Aug-1995
MISS PART 2 EXT	25-Oct-1995	Reminder	17-Aug-1995
MISS PART 1 EXT	25-Sep-1995	Reminder	17-Aug-1995
POSTCARD REC'D	16-Sep-1995	Reminder	

Country Application

Monday, October 22, 2001

FILING RECEIPT	07-Sep-1995	Reminder	07-Aug-1995
IDS	07-Sep-1995	Due Date	07-Sep-1995
MISSING PARTS	25-Aug-1995	Due Date	17-Aug-1995
POSTCARD REC'D	17-Jul-1995	Reminder	07-Aug-1995

MYELOS 002 DV2

NAI



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

P75M
KNOBBE, MARTENS, OLSON & BEAR, LLP
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH CA 92660

DATE PRINTED

8/28/01

MAINTENANCE FEE REMINDER

According to the records of the Patent and Trademark Office, the maintenance fee for the Patent(s) listed below, for which the above address is of record as the fee address under CFR 1.363 has not been paid within the six-month period set forth in 37 CFR 1.362(d). THE MAINTENANCE FEE MAY STILL BE PAID WITH THE APPLICABLE SURCHARGE SET FORTH IN 37 CFR 1.20(k) or (l), WITHIN THE SIX-MONTH GRACE PERIOD SET FORTH IN 37 CFR 1.362(e).

Each patent for which the applicable maintenance fee is not paid to the Patent and Trademark Office on or before the date the fee is due or within the grace period, accompanied with the applicable surcharge if paid within the grace period, WILL EXPIRE AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b).

A PATENT EXPIRES AT THE END OF THE SAME DATE (ANNIVERSARY DATE) THE PATENT WAS GRANTED IN THE 4TH, 8TH, OR 12TH YEAR AFTER THE GRANT DEPENDING ON WHICH MAINTENANCE FEE WAS NOT PAID. 37 CFR 1.362(g).

THE PAYMENT DUE AS SET FORTH BELOW IS BASED ON THE SMALL ENTITY STATUS ACCORDING TO CURRENT OFFICE RECORDS.

TIMELY PAYMENT OF THE TOTAL FEE DUE IS REQUIRED IN ORDER TO AVOID EXPIRATION OF THE PATENT. NOTE 37 CFR 1.378.

PATENT NUMBER	MNT FEE AMT	SUR CHG	U.S. SERIAL NUMBER	PATENT DATE	APPLI- CATION FILE DATE	PAY- MENT YEAR	SMALL ENT- ITY ?	TOTL PAYM DUE	ATTORNEY DOCKET NUMBER
5714459	425	65	08484594	2/ 3/98	6/ 7/95	04	YES	490	OBRIEN.002DV

DOCKETED ON: SEP 24 2001
BY: RS VERIFY BY: [Signature]
ACTION: 3 1/2 YR. M/FEE W/ SURCHARGE
DATE D/T: FEBRUARY 3, 2002
FINAL DEADLINE: FEBRUARY 3, 2002
ATTY: NAI
ATTORNEY VERIFICATION OF DUE
DATE AND FINAL DEADLINE: _____

DIRECT THE RESPONSE TOGETHER WITH A COPY OF THIS NOTICE, AND ANY QUESTIONS ABOUT THIS NOTICE TO:
COMMISSIONER OF PATENTS AND TRADEMARKS, BOX M. FEE, WASHINGTON, D.C. 20231

RECEIVED
SAN DIEGO, DOCKETING

OCT 01 2001

KNOBBE, MARTENS
OLSON & BEAR, LLP

RECEIVED
NEWPORT BEACH, DOCKETING

SEP 20 2001

KNOBBE, MARTENS, OLSON & BEAR, LLP.

BIO-TECHNOLOGY GENERAL CORP.

70 WOOD AVENUE SOUTH TELEPHONE: 732-632-8800
ISELIN, NEW JERSEY 08830 FACSIMILE: 732-632-8810

ROBERT M. SHAW
Senior Vice President
General Counsel & Secretary

Fax: 212-425-5288

October 11, 2001

Deborah Somerville, Esquire
Kenyon & Kenyon
One Broadway
New York, New York 10004

Re: Myelos

Dear Deborah:

Enclosed for your review are letters received from Knobbe Martens pertaining to various Myelos patent applications to which BTG has not yet responded.

Yours truly,

Bob Shaw/cw

Robert M. Shaw

RMS/cw

Enclosures

Knobbe Martens Olson & Bear LLP

Intellectual Property Law

550 West C Street
Suite 1200
San Diego CA 92101
Tel 619-235-8550
Fax 619-235-0176
www.kmob.com

Eric S. Furman, Ph.D.



September 7, 2001

Robert Shaw
Senior Vice President and General Counsel
Bio-Technology General Corp.
70 Wood Avenue South
Iselin, NJ 08830

Re: **PAYMENT OF MAINTENANCE FEES**
USE OF PROSAPOSIN AND NEUROTROPHIC PEPTIDES DERIVED
THEREFROM
U.S. Patent No. 5,714,459
Issued: February 3, 1998
Our Reference: MYELOS.002DV2

Dear Bob:

To maintain the above-identified patent, a maintenance fee payment must be submitted to the U.S. Patent and Trademark Office by February 3, 2002. Please note that failure to pay the maintenance fee will result in the abandonment of the U.S. Letters Patent.

If you want to extend the life of the above-identified patent for a further four years, please indicate by signing, dating, and marking the box on the enclosed copy of this letter and returning it to us, and we will proceed with payment of the fee and bill you accordingly. The total amount due is \$625, which includes both our service charge of \$200, as well as the government fee of \$425.

Newport Beach
949-760-0404

San Francisco
415-954-4114

Los Angeles
310-551-3450

Riverside
909-781-9231

Patent Jacket Data Sheet



D. SOMERVILLE
D.M. PRAISS
E.M. WIECKOWSKI
C.M. AGUAYO

P36803 US 3

Client Ref

Office NY

Title **PROSAPOSIN AS A NEUROTROPHIC FACTOR**

Prosecution Particulars

Prosecution Status	Live - Granted/Registered		
Priority Claimed	08/100247	30-Jul-1993	United States
Parent	08/100247	30-Jul-1993	US
Application	08/484594	07-Jun-1995	United States
Filed on			
Publication			
Allowed			
Grant Fees Paid			
Grant	5714459	03 Feb 1998	
Expiry			
Agent	KENYON N.Y.		

Parties

Inventor	O'BRIEN, S. John
	KISHIMOTO, Yasuo
Reel/Frame	8933/0763

Renewal Particulars

Renewal Status	Granted
Annuity	8
Next Due	03-Aug-2005
Next Cost	1010
Cost Rest of Life	1550

Comm Date	Communication / Action	Due Date	Last Date	Response Filed
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